REMARKS

Claims 1-37 are pending in the application; claims 12-20 and 33-36 have been withdrawn from consideration; claims 1-11, 21-32 and 37 have been rejected.

35 U.S.C. 121

The Examiner, under 35 U.S.C. 121, requested that the Applicant elect a single disclosed species for prosecution on the merits. On December 8, 2003, the Applicant's attorney, Paul Leipold, made a provisional election with traverse to prosecute the invention of species I (ionic conductor). The Applicant now affirms that election.

Claim 1 which is being examined is drawn to a composition comprising a conductive agent; a search on claim 1 would necessarily cover all three groups—I, II, and III. It would seem that the examination of all three groups together would be more economical in time and money without being unduly burdensome on the Examiner. The Applicant requests withdrawal of the election of species requirement under 35 U.S.C. 121.

MPEP §609 A (1)

The Examiner quoted from MPEP §609 A (1), reminding Applicant of the need for a proper Information Disclosure Statement. During a telephone interview with the Applicant's attorney, Doreen Wells, on March 24, 2004, the Examiner stated that his record shows that he received, considered and initialed two separate PTO-1449 forms; one mailed March 28, 2002 and the other on June 03, 2003. He added that there is no need for the Applicant to mail in the return receipt cards.

U.S.C. 102(b) and U.S.C. 103(a)

Before addressing individually the many references cited under U.S.C. 102(b) and U.S.C. 103(a), the Applicant will make a general statement about the purpose, novelty and unobviousness of the present invention.

In a continuing effort to monitor and limit the organic waste it emits into the environment, Eastman Kodak Company designed and built a coating machine that functions only with aqueous coating solutions. As a complement to this effort, the Applicants invented the present aqueous

composition for coating an antistat layer. Hence, page 9, line 2 of the application discloses suitable water-borne chlorinated polyolefins, and page 14, last three lines, discloses that aqueous coating compositions are preferred.

All the references cited teach coating compositions with varying amounts of organic solvents required, not just optional. Some references state the need/purpose of the solvent (e.g., evaporation), some specify a minimum amount that must be present; but none teaches an aqueous medium as the Applicant does. Claim 1 (and with it the dependent claims) has been amended to recite "water" as the solvent. The 35 U.S.C. 102(b) rejections are therefore not appropriate and should be withdrawn.

It is well established that a proper 35 U.S.C. 103(a) reference must provide a teaching, motivation or incentive for the invention. In the present case, one skilled in the art looking for an environmentally friendly coating and especially having to avoid organic solvents, would not look to the cited references that teach "at least" a certain amount of it in the composition. The references therefore do not support the 35 U.S.C. 103(a) rejection, hence the rejections should be withdrawn.

The Applicant will now turn to the particular references.

Zaleski

Claims 1, 3-11, 21-32, 37 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zaleski (USP 4,981,729). The Applicant respectfully traverses this rejection.

Zaleski discloses coating compositions comprising film forming resins, which among many choices could include chlorinated polyolefins. However, as correctly noted by the Examiner, the coating composition requires the use of at least one volatile organic liquid (See, page 7, line 2, of the Office Action). Eastman Chemical Products' CP-343-1 and CP 343-2, designated by Zaleski as useful chlorinated polyolefins, were disclosed to be at 40-50% concentration in xylene (col.7, ll. 50-55). Example 1 of electroconductive compositions described in US Patent 4,981,729 contains at least 70-85% of volatiles; Example 2 contains 85.6%. In contrast, the aqueous composition of the amended claims in the instant application requires no such volatile organic liquid

and in fact, is designed to avoid it. The Applicant requests that the rejection be withdrawn.

Winnik et al.

Claims 1-4, 9-11, 21-32, 37 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Winnik et al. (USP 5,378,574). The Applicant respectfully traverses this rejection.

Winnick et al. also discloses the use of organic solvents. As the Examiner observes, Winnik uses Eastman Chemical Products' CP-343-1, a product already shown above to be in 40-50% xylene.

Moreover, Winnik et al. describes their resins as soluble in the liquid vehicle at elevated temperatures but insoluble at ambient temperatures. It is known in the art that chlorinated polyolefins are not soluble in water at any temperature and that the behavior described in the reference is typical of organic solvent vehicles. In contrast, the Applicant's preferred resins are described in the paragraph bridging pages 8 and 9 of the specification; they are water-borne dispersions. The Applicant requests that the rejection be withdrawn.

Delnick et al.

Claims 1-4, 9-11, 21-32, 37 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Delnick et al. (USP 6,148,503). The Applicant respectfully traverses this rejection.

Delnick et al. in US Patent 6,148,503 describes a porous separator for electrochemical power supply. The patent discloses the use of coating compositions comprising chlorinated polyolefins in organic solvents (60-95% by mass) (See, col. 8 ll. 1-12). This again differs from the Applicant's aqueous solution.

The resultant porous layers of Delnick et al. are not by themselves electrically conductive, as they were meant to function as separators between electrodes, as described in col. 12, ll. 57 –col. 13, l.5. One skilled in the art wishing to make an antistat layer such as is used in imaging elements, would not

look to a separator for electrochemical power supply for teaching. The reference is not appropriate in this case.

Furthermore, like Winnik, Delnick describes his resin as soluble in the liquid vehicle at elevated temperatures but insoluble at ambient temperatures. It is known in the art that chlorinated polyolefins are not soluble in water at any temperature and that the behavior described in the reference is typical of organic solvent vehicles. In contrast, the Applicant's preferred resins are described in the paragraph bridging pages 8 and 9 of the specification; they are water-borne dispersions. The Applicant requests that the rejection be withdrawn.

Claims 1, 3-8, 21-29 and 37 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schreiber et al. (USP 5,804,615). The Applicant respectfully traverses this rejection.

Schreiber et al. discloses coating compositions comprising electrically conductive pigments, with or without chlorinated polyolefin. In col. 2 l. 20, Schreiber et al. states the objective of reducing the use of chlorinated polyolefin. Thus, US Patent 5,804,615 teaches away from using chlorinated polyolefins. Also, the reference requires the use of one or more organic solvents (col.2, l.36; also claim 1). In fact, US Patent 5,804,615 describes adhesion problems with aqueous coatings of chlorinated polyolefins (col. 1 ll. 35 – 46). Additionally, the coating composition appears to be of limited stability, as the ingredients are suggested to be mixed only "immediately prior to application" (col. 2 ll. 44-47).

The Applicant requests that the rejection be withdrawn.

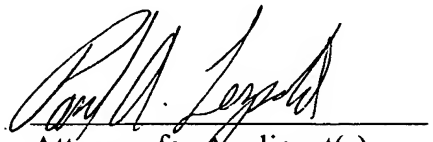
Claims 1, 21-23, 27-29 and 37 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Enlow et al. (USP 6,001,207). The Applicant respectfully traverses this rejection.

Enlow et al. teaches a solvent based composition (See, e.g., the formulations copied by the Examiner into the Office Action where toluene is the solvent; See, also, col. 6, ll. 47-51 and l. 61). The solvent is relied upon for drying by solvent evaporation (See, col. 3, ll. 65-67; also col. 4, ll. 12-13.

The Applicant requests that the rejection be withdrawn.

The Applicant believes that the application is in condition for allowance and looks forward to an early Notice of Allowability.

Respectfully submitted,



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